

09/426,063

GEDP106US

REMARKS

Claims 1-8 and 39-50 are currently pending in the subject application and are presently under consideration. Claims 1, 39, 40, 47 and 50 have been amended herein. A complete listing of the claims showing the changes made can be found at pp. 5-8 of this Reply. In addition, the specification has been amended as indicated on pp. 2-4.

Favorable reconsideration of the subject patent application is respectfully requested in view of the comments and amendments herein.

I. Rejection of Claims 1-8, 39 and 47-50 Under 35 U.S.C. §101

Claims 1-8, 39 and 47-50 stand rejected under 35 U.S.C. §101 because the claimed invention is directed to non-statutory subject matter. Withdrawal of this rejection is respectfully requested for at least the following reasons:

In particular, the Examiner contends that, "[t]he recited steps offering, inputting, correlating and outputting, does not apply, involve, use, or advance the technological arts since all of the recited steps can be performed in the mind of the user or by use of a pencil and paper." However, the claims of the subject invention are directed toward computer implemented methods to conduct business electronically, which falls squarely within the allowable subject matter of patentable inventions as provided by 35 U.S.C.S. § 101. The Examiner contends that the computer implemented method language occurs in the preamble and does not give life meaning and vitality into the claim as required under *Catalina Marketing v. Coolsavings*, 289 F.3d 801, 808 (Fed Cir. 2002). However, the Examiner has fails to recite the complete holding in that case which states that a preamble limits the invention, *if it recites essential structure* or steps or if it is necessary to give life, meaning, and vitality to the claim. *Id.* The preamble in claim 1 recites both a computer and a network, both providing essential structure. It seems unreasonable to argue that a claim that recites "A computer implemented method for transacting business over a network" is not limited to the technological art and only constitutes an idea of how to transact business. Nevertheless, to appease the Examiner, claims 1 and 40 have been amended to recite a computer in the body of the claim. Claim 47 currently recites a computer system and claim 50 recites a means for offering a list of deals electronically to potential buyers. Accordingly, independent claims 1, 40, 47, and 50 either involve, use,

09/426,063

GEDP106US

or advance the technological arts and are thereby within the technological arts. By virtue of their dependency claims 2-8, 39, 41-46, and 48-50 include all the limitations of the independent claims from which they depend. Accordingly, this rejection should be withdrawn.

II. Rejection of Claims 1-8 and 39-50 Under 35 U.S.C. §112

Claims 1-8, 39-50 stand rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Withdrawal of this rejection is respectfully requested for at least the following reasons:

The Examiner alleges the phrase "at least one distribution attribute" is not clear, and, further, that no support for such language can be found in the descriptive portion of the specifications. For clarity, "distribution attribute" has been amended herein to recite "distribution criterion." This term more clearly points out and distinctly claims the subject matter the applicant regards as the invention by identifying specific non-price criteria that include at least one distribution criterion. More specifically, this suggests one of the non-price criteria pertains to the act or process of distributing or delivering. Support for this language can be found in the specification, for example the specification provides for "delivery options," "delivery time," "delivery range," and "warranty" (*e.g.*, FOB origin, FOB destination) (*See*, page 8, lines 19-26, page 11, line 26, page 3, lines 12-16). Accordingly, this rejection should be withdrawn in regard to claims 1-8 and 39-50.

As per claim 47, the Examiner notes that the phrase "via network" is not clearly written and must be corrected. Since, such a phrase does not appear in claim 47, applicant's representative will assume that Examiner meant "via computer system." Claim 47 has been amended to recite the phrase "via a computer system." Hence, this rejection should be withdrawn.

III. Rejection of Claims 1-8 and 39-50 Under 35 U.S.C. §103(a)

Claims 1-8 and 39-50 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Libman (U.S. 5,987,434). Withdrawal of this rejection is respectfully

09/426,063

GEDP106US

requested for at least the following reasons:

Libman, alone and/or in combination with any of the cited references, fails to disclose, teach or suggest each and every feature set forth in the subject claims.

To reject claims in an application under §103, an examiner must establish a *prima facie* case of obviousness. A *prima facie* case of obviousness is established by a showing of three basic criteria. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. *Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.* See MPEP §706.02(j). The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. See *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991) (emphasis added).

In particular, Libman does not disclose, teach, or suggest inputting a plurality of price and non-price *buying criteria by a buyer* for the at least one product and service, as recited by independent claim 1; *buying criteria defined by the buyer*, as recited by claim 40; at least one *buyer defined* price and non-price *buying criteria*, as recited by claim 47; and receiving one more price and non-price *buying criteria from one or more buyers*, as recited by claim 50. Instead, Libman discloses a database that stores client information. (See col. 8, ln. 66-67). The seller collects this information based upon seller criteria, and although the client must provide the information, the information provided is merely *about* the client, not the buyer's buying criteria. (See col. 9, ln 1-40). Hence, it is seller criteria, not *buying criteria by a buyer*. Additionally, Libman teaches away from this element because, while it does attempt to accommodate various buyer needs, it only does so based upon the seller's viewpoint of what needs are important. Thus, Libman can accommodate any type of client information that can be incorporated into the client database (*i.e.* by the seller). (See col. 9, ln. 63-65). However, it does not attempt to provide for buying criteria by a buyer to be incorporated into the client database, and to do so would contravene much of the optimization and automation methods disclosed (*e.g.*

09/426,063

GEDP106US

the decision logic disclosed to automate the Virtual Agent™ Module). Therefore, adding this element to the cited art would not be obvious to one of ordinary skill in the art, and there is no motivation to do so because such a change would be counterproductive to the methods disclosed in Libman.

In addition, the Examiner notes that Libman does not explicitly disclose "at least one distribution criterion," as recited by independent claims 1, 40, 47, and 50. However, the Examiner suggests the buyer and seller criteria analyzed in columns 9-20 of the reference as may be viewed as distribution attributes, yet, what is cited generally points to nothing that can be construed to teach or suggest at least one distribution criterion (of a non-price buying criteria by a buyer). Instead, the relevant passages refer to client information that the seller chooses to use to make a proposal, not at least one distribution attribute a buyer uses to accept a deal. Furthermore, as recited above, this addition is not obvious to one of ordinary skill in the art because it would contravene much of the automation methods disclosed by Libman. Hence, such a modification would be counterproductive, thereby eliminating any perceived benefits (and motivation) otherwise to be gained (*i.e.* to increase sales for increased profits, as the Examiner suggests).

In light of the above, the rejection of independent claims 1, 40, 47, and 50 (as well as claims 2-8, 39, 41-46, 48 and 49 depending thereon) should be withdrawn.

09/426,063

GEDP106US

CONCLUSION

The present application is believed to be in condition for allowance in view of the above comments and amendments. A prompt action to such end is earnestly solicited.

In the event any fees are due in connection with this document, the Commissioner is authorized to charge those fees to Deposit Account No. 50-1063 [Ref: GEDP106US].

Should the Examiner believe a telephone interview would be helpful to expedite favorable prosecution, the Examiner is invited to contact applicant's undersigned representative at the telephone number below.

Respectfully submitted,

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